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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10-036,866	12-21-2001	Edouard A. Mamedov	STC 01-0002	4021

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07-02-2003

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EXAMINER

SAEED, KAMAL A

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 07/02/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,866

Applicant(s)

MAMEDOV ET AL.

Examiner

Kamal A Saeed

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-128 is/are pending in the application.
- 4a) Of the above claim(s) 18-128 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1626

Claims 1-128 are pending in this application. Claims 18-128 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

Response to Restriction

Applicants' representative, Mr. Jim Wheelington, made an election with traverse to Group I, claims 1, 2 and 13, directed to a catalyst composition of the formula depicted in claim 1, is acknowledged.

The traversal is on the ground(s) that each of the elected group could be extended to other group without imposing an undue burden on the Examiner. Applicants argument is partially persuasive and the restriction requirement have been modified as follows:

Group I claims 1-17, are drawn to a catalyst composition

Group II claims 18-106, are drawn to a process of making a catalyst

Group III claims 107-128, are drawn to a method of using the product.

The following is a recitation of M.P.E.P. §821.04, Rejoinder:

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02© and § 821 through § 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims, which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Where product and process claims are presented in a single application and that application qualifies under the transitional restriction practice pursuant to 37 CFR 1.129(b), applicant may either (1) elect the invention to be searched and examined and pay the fee set forth in 37 CFR 1.17(s) and have the additional inventions searched and examined under 37 CFR 1.129(b)(2), or (2) elect the invention to be searched and examined and not pay the additional fee (37 CFR 1.129(b)(3)). Where no additional fee is paid, if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims which either depend from or include all the limitations of the allowable product will be rejoined.

Art Unit: 1626

If applicant chooses to pay the fees to have the additional inventions searched and examined pursuant to 37 CFR 1.129(b)(2), even if the product is found allowable, applicant would not be entitled to a refund of the fees paid under 37 CFR 1.129(b) by arguing that the process claims could have been rejoined. 37 CFR 1.26 states that "[m]oney paid by actual mistake or in excess will be refunded, but a mere change of purpose after the payment of money...will not entitle a party to demand such a return..." The fees paid under 37 CFR 1.129(b) were not paid by actual mistake nor paid in excess, therefore, applicant would not be entitled to a refund.

In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104 - 1.106. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action.

The following is a recitation from paragraph five, "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. §103(b)" (1184 TMOG 86(March 26, 1996)):

"However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim **depends from or otherwise includes all the limitations of an allowed product claim**. Withdrawn process claims not commensurate in scope with an allowed product claim will not be rejoined." (emphasis added)

Therefore, in accordance with M.P.E.P. §821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until, such time, a restriction between product claims and process claims is deemed proper. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to maintain either dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Therefore, the restriction requirement deemed proper and is made FINAL.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants preserve their right to file a divisional on the non-elected subject matter.

Art Unit: 1626

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brazdil et al US 5,008,427.

Applicants claim a catalyst composition of the formula $\text{VSb}_a\text{M}_b\text{O}_x$, $\text{VSb}_a\text{M}_b\text{M}'_{b'}\text{O}_x$, $\text{VSb}_a\text{M}_b\text{Q}_c\text{O}_x$, $\text{VSb}_a\text{M}_b\text{Q}_c\text{Q}'_{c'}\text{O}_x$ (wherein V is vanadium, Sb is antimony, M and M' represent one element selected from the group consisting of Mg, Al, Zr, Si, Hf, Ti and Nb; Q and Q' represent one element selected from the group consisting of K, Ca, B, Ag, Cu, Bi, Ga, In, Fe, Co, Ni, Sr, Sn, La, W, Zn and Cd; a is 0.5-20; b is 2-50; b' is 0-50; c and c' are 0-10; x is determined by the valence requirement of the other elements).

Determination of the scope and content of the prior art (MPEP §2141.01)

Brazdil et al teach a catalyst composition used in the vapor phase ammoxidation of paraffin. The catalyst have an empirical formula of VSbmAaDdO_x , wherein A is one or more element selected from the Ti, Sn, Fe, Cr or Ga; D is one or more element selected from the group consisting of Li, Mg, Ca, Sr, Ba, Co, Ni, Zn, Ge, Nb, Zr, Mo, W, Cu, Te, Se, Bi, Ce, In, As, B, and Mn; m is 0.8-4; a is 0.01-2 and d is 0-2.

Art Unit: 1626

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

Brazdil et al is analogous art because Bradzil et al catalyst composition possesses similar element composition (See '427, column 5, Table A, example M) and possesses similar activity. The difference between the claimed mixed metal oxide catalyst and that of the reference herein lie in that that applicants claim the V and Sb are isolated in matrix of the oxides of M.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

One having ordinary skill in the art would find Brazdil et al prima facie over the instant claims because the instant claims are analogous composition with some variation in qualitative relationship among the various components. Guided by the multiple examples, one skilled in the art would expect the generic disclosure of Brazdil et al encompassed the variation of quantities of the instant claims to operate in the same manner. There is nothing unobvious in isolating the Vanadium and antimony in matrix of oxides of M, because the prior art catalyst is used for the same purpose. The motivation to make claimed mixed metal oxide catalyst with similar ratios that are used as catalysts arises from the expectation that structurally similar mixed metal catalysts are generally expected to have similar properties and have similar utilities.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal Saeed whose telephone number is (703) 308-4592. The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308 4537. The unofficial fax phone for this group are (703) 308-4556 or 305-3592.

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Art Unit: 1626

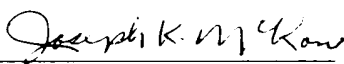
"Official" for papers that are to be entered into the file, and " Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application.

This will expedite processing of your papers.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

Kamal Saeed, Ph.D
June 26, 2003



Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1